

REMARKS

This petition is brought on the ground that the restriction requirement under 35 U.S.C. §121 is improper. The following reasons are advanced in support of Applicants' contention:

A. Statement of Facts:

In the Office Action mailed on February 1, 2005, the Examiner made a two-way restriction requirement under 35 U.S.C. § 121 to one of the following inventions:

- I. Claims 1-48, 89-93, 97, 98, and 101-119, drawn to an apparatus for wrapping a load, classified in class 053, subclass 556.
- II. Claims 50-88, 94-96, 99, and 100, drawn to a method for wrapping a load, classified in class 053, subclass 399.

Next, the Examiner made a thirteen-way restriction requirement, dividing Group I into sub-groups 1-7, and dividing Group II into sub-groups 1-6. If Applicants elected Group I, then Applicants were required to elect one of the following sub-groups:

1. Claims 1-8, 112-114, 116, and 117;
2. Claims 9-19 and 119;
3. Claims 20-34, 93, and 115;
4. Claims 35-38 and 89-92;
5. Claims 39-48, 97, and 98;
6. Claims 101-111; and
7. Claim 118.

If Applicants elected Group II, then Applicants were required to elect one of the following sub-groups:

1. Claims 50-52 and 54-57;

2. Claims 59-63;
3. Claims 64-72, 58, 88, and 94;
4. Claims 73-78, 86, 87, 96, 99, and 100;
5. Claims 79-85 and 53; and
6. Claim 95.

The Examiner contended that the inventions of sub-groups 1-6 were unrelated, asserting that the different inventions as defined by each of the claimed sub-groups 1-6 neither recites nor requires the inventions as defined by the claims of each of sub-groups 1-6. The Examiner also asserted that restriction was proper because the inventions of sub-groups 1-6 have acquired a separate status in the art as shown by their different classification, and because of their recognized divergent subject matter.

In response, Applicants filed an amendment dated March 1, 2005, electing sub-group 1 of Group II with traverse. Applicants asserted that the thirteen-way restriction requirement, requiring Applicants to elect one of sub-groups 1-6 from Group II, was improper. Accordingly, Applicants requested that the thirteen-way restriction requirement be withdrawn and sub-groups 1-6 be examined together on their merits in this application.

The Examiner, in the Office Action mailed on April 13, 2005, disagreed with Applicants' assertion that the thirteen-way restriction requirement was improper. The Examiner contended that the inventions of sub-groups 1-6 were directed to different subject matter, giving the example of some of the sub-groups referring to "A method for wrapping a load," and other to "A method for securing a load to a pallet." The Examiner also argued that by showing the difference between sub-groups 1-6, it was inherent that

a burden would be on the Examiner in regard to examining and searching in different areas for different inventions, and that searching for all six sub-groups would require much more searching in different areas; further, even if searching could all be done in the same area, the Examiner would still be burdened. The Examiner therefore denied Applicants' request to have each of sub-groups 1-6 examined on the merits, deemed the thirteen-way restriction requirement as proper, and made the thirteen-way restriction requirement final.

B. The Restriction Requirement is Improper:

Applicants do not contest the two-way restriction requirement between the method and apparatus because the two-way restriction is based upon the subject matter of the restricted claims. However, Applicants contest the thirteen-way restriction requirement as being improper for several reasons. One reason being that the restriction seems to be based on the number of claims and not on the subject matter of those claims. For example, claim 14 was restricted into sub-group 2 of Group 1 while claim 20 was restricted into sub-group 3 of Group 1. Applicants submit, however, that claims 14 and 20 address similar subject matter, and consideration should be given as to whether the USPTO would want to issue two separate patents on these claims. Another example of this kind of situation arises with regard to claims 3 and 19. Thus, it is apparent the thirteen-way restriction requirement fails to separate the claims into groups based on subject matter and is improper.

The proper way to break down the claims into various elements/embodiments is by an election of species requirement. Because the Figures could not support such a species requirement, the Examiner apparently attempted to make an election

requirement by separating the independent claims and grouping them by elements. However, Applicants are permitted to describe their invention in more than one independent claim. Thus, the fact that several independent claims are pending is insufficient grounds for making the thirteen-way restriction requirement set forth by the Examiner.

The thirteen-way restriction requirement is also improper because the claims of sub-groups 1-6 do not define independent inventions. For the claims to be independent, they must be directed to different combinations, not disclosed as capable of use together, having different modes of operation, or different functions or effects. (MPEP § 806.04). The MPEP provides some examples of independent inventions. One example is an article of apparel, such as a shoe or necktie, and a locomotive bearing. (See id.; MPEP § 808.01). Another example is a process of painting a house and a process of boring a well. (See MPEP § 806.04). While the meaning of the terms used in the MPEP to define “independent” inventions may be vague, the examples provided for context are not. In order for the groups of claims to be restricted as being directed to independent inventions, the claims must be directed to entirely and completely different subject matter. In fact, the MPEP explicitly states that independent inventions are “but rarely presented, since persons will seldom file an application containing disclosures of independent things.” (See § MPEP 808.01). This suggests that independent inventions are entirely and absolutely exclusive of one another. This is not the case in the sub-groups of claims cited in the thirteen-way restriction in the present application.

In contrast to the examples of independent inventions set forth in the MPEP, the claims of sub-groups 1-6 in the present application are all directed toward a method of wrapping a load. Thus, the subject matter of the claims of sub-groups 1-6 is not independent as would be a necktie and a locomotive bearing. Therefore, the claims are not independent as suggested in the Office Action.

Furthermore, by classifying all method claims 50-88, 94-96, 99, and 100 as being drawn to a single invention in Group II, characterized as a method of wrapping a load on page 2 of the Office Action, the Examiner already categorized those method claims as being related to the practice of a single invention. To further sub-divide these claims by element and state that the inventions of sub-groups 1-6 are unrelated (page 4 of the Office Action mailed February 1, 2005), after classifying these claims as being drawn to a single invention, was improper and contradictory.

In addition to requiring that the inventions of sub-groups 1-6 be independent of one another, a proper restriction requires that the examination of all sub-groups impose a serious burden on the Examiner. See MPEP § 803.01. As discussed in detail in the response to the Restriction Requirement filed on March 1, 2005, the Examiner has not shown that a serious burden has been imposed.

Although the Examiner has not established that there would be a serious burden, Applicants are sympathetic to the Examiner's contention that searching for all of the pending claims would be a burden. Still, Applicants maintain that the restriction requirement should have been based upon the subject matter of the claims and not on the number of the claims. As such, a more acceptable restriction requirement could have been made by separating the independent claims into three general categories

according to subject matter. For example, a restriction could have been made between claims directed towards rolling the film (e.g., 50, 59, 86, 94, and 95); claims directed towards driving the film downward (e.g., 64, 73, 87, 88, 96, and 99); and claims directed towards biasing the film (e.g., 79). If absolutely necessary, these categories could have been further narrowed to one of methods and apparatuses, resulting in a six-way restriction. This type of subject matter based restriction requirement would have been proper and more acceptable than the improper thirteen way restriction requirement set forth by the Examiner.

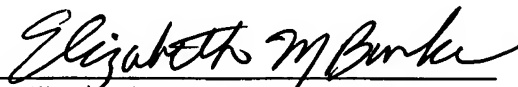
In view of the foregoing, it is submitted that an improper thirteen-way restriction requirement under 35 U.S.C. §121 was made in the Office Action dated February 1, 2005. It is submitted that the circumstances here involved are such that the thirteen-way restriction requirement should be withdrawn and that Applicants should be entitled at least to the examination on the merits of all of the claims in Group II, including claims 50-88, 94-96, 99, and 100. Alternatively, Applicants request the withdrawal of the improper restriction requirement and an Office Action setting forth a new, proper restriction requirement. Applicants further request an Office Action on the merits of the improperly withdrawn claims and the already treated claims.

Please grant any extensions of time required to enter this petition and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 30, 2005

By: 
Elizabeth M. Burke
Reg. No. 38,758